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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,574	04/02/2004	Daryl Hamilton	08049.0929	3806

7590 02/02/2010

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EXAMINER	
AMSDELL, DANA	
ART UNIT	PAPER NUMBER
3627	

MAIL DATE	DELIVERY MODE
02/02/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/817,574	HAMILTON, DARYL	
	Examiner	Art Unit	
	DANA AMSDELL	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 December 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/6/2009 and 12/31/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Remarks

Applicant's remarks with respect to amended claim 1, 7, and 13 have been considered but are moot in view of the new ground(s) of rejection. Amended feature "having a uniqueness requirement of a predetermined time period" warrants new search and, subsequently a new art rejection.

In response to applicant's remarks that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.1992). In this case, one of ordinary skill in the art would find it obvious to combine the teachings of Sansone to Radican as applied to the immediate claims in an attempt to solve logistic issues of getting, generically speaking, containers with contents from point A to point B, (i.e. 'postal trays' or 'inventories in transport'). As stated in the prior Office action, dated 8/31/2009, the differences between the prior art and the Applicant's claims are trivialized in the consideration of this common mission, and the motivation of reducing 'effort', which translates to be reduced time, costs and labor. New prior art rejection finds it 'obvious

to combine or modify' Sansone and Radican rationale, as it applies to the art of label generation and the amended claim limitation.

Applicant's remarks suggesting Sansone fails to teach a unique label in his teaching of a one-time label printing, have been considered and are unpersuasive, using rationale found in the 8/31/2009 Office action. Remarks directed to Sansone failing to teach to the amended claim limitation "having a uniqueness requirement of a predetermined time period", have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 7 , and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Cited support in the Specification for the amended limitation "having a uniqueness requirement of a predetermined time period", is ambiguous.

Paragraph 29 is directed to time-dependent tray identification –

> "Enhanced label 120c is placed onto a tray 125 in order to uniquely identify tray 125. Uniquely identifying tray 125 should not be construed as requiring an absolutely unique identifier for tray

125, but, as is understood by those skilled in the art, as sufficiently unique enough to distinguish tray 125 from other trays within a reasonable time period, e.g., within a one year time frame.".

Paragraph 73, on the other hand is directed to the enhanced label having a serial number-

"The printing system of the present invention does not need to utilize the key fields in generating unique labels for trays and sacks. For example, in a situation with a 30 day uniqueness requirement, if a mailer having its own 7-digit Mailer ID only generates 100,000 trays per month, the mailer only needs to increment the variable Serial Number field for each successive label. If, however, the mailer generates 1,800,000 trays using various ZIPs and CINs, the mailer's printing system could choose to track the changes in CIN or ZIP key fields in determining when it may need to increment the variable Serial Number field. Once the length of uniqueness is defined, maintaining uniqueness of the tray identifier for its entire life may be accomplished through serialization management. "

For the purpose of examination, the limitation as it is directed to a label in the context of the claim will be regarded as an enhanced label having a serial number.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-6 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.
The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Radican (US 6,148,291)' herein "Radican"; in view of Sansone (US 5,216,620), herein "Sansone"; and further in view of Albright et al. (US 6,746,164), herein "Albright".

6. Regarding claims 1,7 and 13 being to a method, system and computer readable medium (column 4, lines 37-43), directed to tracking a tray of items, Radican teaches the receipt of a load container scan, the load container scan associating the container unique identifier with 'hard copy reports' (Fig. 3 - 'Status', and column 7, lines 42-44). Radican also discloses load content and status 'labels' with the monitoring system and an embodiment utilizing "enhanced" label technology for container application (column 13, lines 18-30), without actually specifying affixed labels;.

Sansone, however, does teach directly to a generated enhanced label (Fig. 1, elm. 22), the enhanced label comprising a routing code, the enhanced label being applied to the tray; associating a tray with a container, the container having a container unique identifier (Fig. 2b, column 1, lines 37-59; and column 4, lines 30-40). One of

ordinary skill in the art at the time of invention would find it obvious to modify the teachings of Radican by Sansone's disclosure of mail transit logistics (enabled by an enhanced label/tray system and method), as they overlap in providing a technology retro-fitted solution to problematic logistics; and as to achieve the highly desirable outcome of "the amount of effort can be reduced"; (see Sansone- Background).

Neither Radican or Sansone teach to the enhanced label having a serial number effectively functioning to "hav[e] a uniqueness requirement of a predetermined time period". However, Albright discloses in his method and system of tracking printed articles (labels) with a serial number unique to the label Fig. 6, elm. 606; and column 5, lines 35-47). One of ordinary skill in the art would find it obvious to modify the teachings of labeling of Sansone and Radican to include Albright' teaching of including a serial number that provides label generation run-time information, thus giving increased distinction to the article it is affixed to, and avoiding 'delays in shipping' (Albright – column 1, lines 32-42).

7. Regarding claims 2, 3, 8, 9, 14 and 15, Radican, Sansone, and Albright teach the claim dependencies, and Radican further teaches receiving a load vehicle scan, the load vehicle scan associating the container unique identifier with a vehicle identifier and a load and unload time (Fig., elm. V, Fig. 3- association between 'Status' and 'Time', and column 8, lines 45-55).

8. Regarding claims 4, 10, and 16, Radican, Sansone, and Albright teach the claim

dependencies, and Radican further teaches receiving an unload container scan, the unload container scan associating the container unique identifier with an unload container time (Fig. I, elm. C; and column 4, lines 60-67).

9. Regarding claims 5, 11, 17, 19 and 20, Radican, Sansone, and Albright teach the claim dependencies, and Sansone further teaches wherein the label unique identifier comprises at least one of a machine identifier, a label source, a holdout identifier, a serial number, and a label type (Fig 2b and column 4, lines 30-42 (label type being alpha-numeric barcode)); wherein the label type comprises a constant field (Fig. 2B, elm. 57-contract ID), a key field (Fig. 2B, elm. 52 –Zip code as defined by Applicant's Specifications as a "key" field) and a variable field (Fig. 2B, elm. 66 – weight).

10. Regarding claim 6, 12 and 18, Radican, Sansone, and Albright teach the claim dependencies, and Sansone further teaches wherein the routing code comprises at least one of a destination code, a content identifier number, a DOD code, and an MPC code (Fig. 2a - first 5 numbers of barcode being the destination code represented by the ZIP code).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANA AMSDELL whose telephone number is (571)270-5210. The examiner can normally be reached on 5/4/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DA

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627